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REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims comply with 35 U.S.C. § 112, comply with 35 U.S.C. § 101, are not anticipated under 35 U.S.C. § 102 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.

The applicants will now address each of the issues raised in the outstanding Office Action.

Objections

The drawings were objected to under 37 C.F.R. § 1.83(a) as not showing every feature of the invention specified in claims 1-28. The applicants respectfully request that the Examiner withdraw this objection in view of the following.

Independent claim 1, as amended, recites a computer-implemented method which includes the acts of (a) determining whether or not a condition is met, responsive to an ad request associated with a target document, wherein the target document is associated with a resource for rendering content; (b) if it is determined

that the a condition is met, a first entity providing a set of at least one ad to be rendered via the resource; and (c) if it is determined that the condition is not met, the first entity signaling the availability of at least a portion of the resource to a second entity to render content. Each of the aforementioned features recited in claim 1, as amended, is shown in Figure 4. Specifically, block 420 illustrates the act of determining whether or not a condition is met, responsive to an ad request associated with a target document. Next, if it is determined that the condition is met, block 440 illustrates the act of providing a set of at least one ad to be rendered via the resource. Finally, if it is determined that the condition is not met, block 450 illustrates the act of signaling the availability of at least a portion of the resource to a second entity to render content (i.e., allowing alternative entity to use the resource to render content). Thus, every feature of independent claim 1 is depicted in Figure 4. Claims 2-28 depend from claim 1 and further limit the existing features of claim 1 which are depicted in Figure 4. Thus, the applicants respectfully request that the Examiner withdraw this objection in view of the foregoing remarks.

The title was found to not be descriptive. The title has been amended to be more clearly indicative of the claimed invention. Therefore, the applicants request that the Examiner reconsider and withdraw this objection.

The specification was found to include various trademarks which were not properly indicated as such.

The applicants have amended the specification to address the Examiner's concerns regarding the use of trademarks. The applicants note the Google, Inc. was used as a company name, not as a trademark. Thus, the applicants respectfully request that the Examiner withdraw this objection in view of these amendments.

Claim 12 is objected to for grammatical reasons. Claim 12 has been amended to replace the phrase "determines net revenue" with the phrase "determines if net revenue" as suggested by the Examiner. Thus, the applicants respectfully request that the Examiner withdraw this objection in view of the foregoing amendment.

Claim 13 is objected to since the Examiner states that the step of "determining" is unclear. Claim 13 has been amended to more clearly indicate that the step involves "determining whether or not a payment is to be paid to a publisher for rendering the ad." Thus, the applicants respectfully request that the Examiner withdraw this objection in view of the foregoing amendment.

Claim 20 is objected to for grammatical reasons. Claim 20 has been amended to replace the phrase "the request to a second entity" with the phrase "the request to the second entity" as suggested by the Examiner. Thus, the applicants respectfully request that the Examiner withdraw this objection in view of the foregoing amendment.

Claim 25 is objected to for grammatical reasons. Claim 25 has been amended to more clearly indicate that the first entity will indicate to an external entity that the condition is not met, as suggested by the Examiner. Thus, the applicants respectfully request that the Examiner withdraw this objection in view of the foregoing amendment.

Claims 32-34 are objected to for grammatical reasons. Claims 32-34 has been amended to replace the phrase "determines a threshold" with the phrase "determines that a threshold" as suggested by the Examiner. Thus, the applicants respectfully request that the Examiner withdraw this objection in view of the foregoing amendment.

Claim 36 is objected to for grammatical reasons. Claim 36 has been amended to replace the phrase "whether not to render" with the phrase "whether or not to have the first means render". Thus, the applicants respectfully request that the Examiner withdraw this objection in view of the foregoing amendment.

Rejections under 35 U.S.C. § 112

Claims 1-38 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the matter. Specifically, the Examiner contends that the terms such as "allowing" and "usable" render the claims indefinite because they merely recite a use without any positive steps delimiting how this use is actually practiced.

(See Paper No. 20070521, page 4.) The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Claims 1 and 36 have been amended to remove the use of the terms "allowing" and "usable". These claims, as amended, recite the positive steps of determining..., providing... and signaling....

In view of the foregoing remarks and amendments, the applicants respectfully submit that claims 1 and 36 meet the requirements of 35 U.S.C. § 112, second paragraph. Since claims 2-28, 37 and 38 were apparently rejected solely based on the fact that they depend, either directly or indirectly, from one of claims 1 and 36, these claims similarly meet the requirements of 35 U.S.C. § 112, second paragraph. Accordingly, the applicants respectfully request that the Examiner withdraw this ground of rejection with respect to these claims.

Furthermore, since original claims 29-35 neither contain the language cited by the Examiner (i.e., which the Examiner contends renders the claims indefinite), nor depend, either directly or indirectly, from claims that contain the language cited by the Examiner, the applicants respectfully request that the Examiner withdraw this ground of rejection with respect to these claims as well.

Rejections under 35 U.S.C. § 101

Claims 1-38 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory matter. The applicants respectfully

request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Claims 1-35

With respect to claims 1-35, the Examiner states that "while the practical utility set forth in the description relates to rendering advertisements, the claimed subject matter only provides for allowing a resource to render an ad", and therefore the produced result remains in the abstract. (See Paper No. 20070521, page 5.)

Independent claim 1, as amended, is directed toward statutory subject matter. Specifically, claim 1 has been amended to remove the use of the term "allowing". Claim 1 has also been amended such that, after determining whether or not a condition is met, one of the following positive acts having practical utility will occur: (a) providing, by a first entity, a set of at least one ad to be rendered via the resource; and (b) signaling the availability of the resource to a second entity. Hence, the claims, as amended, provide a concrete and tangible result.

Independent claim 29, as amended, recites an ad system which receives a request to provide content to be rendered in conjunction with a target document, and determines, based on a set of one or more conditions, whether to provide at least one ad responsive to the request, and if not, redirecting the request to an alternative entity. As such, claim 29 provides a concrete and tangible result.

In view of the foregoing remarks and amendments, the applicants respectfully submit that claims 1 and 29 meet the requirements of 35 U.S.C. § 101 and are directed towards statutory subject matter. Since claims 2-28 and 30-35 depend, either directly or indirectly, from claims 1 and 29, respectively, these claims similarly are directed towards statutory subject matter. Accordingly, the applicants respectfully request that the Examiner withdraw this ground of rejection with respect to claims 1-35.

Claims 36-38

In rejecting claims 36-38, the Examiner states that the system recited does not require any hardware, making it software *per se*, and as such, these claims are non-statutory. (See Paper No. 20070521, page 5.) The applicants respectfully disagree.

Software *per se*, without benefit of processor(s) and/or storage device(s), could not perform the functions recited by the means-plus-function claim elements recited in claims 36-38. Figure 3 is a block diagram of an apparatus that might be used to perform at least some of the various functions and to store at least some of the information that may be used and/or generated. The specification includes a description of this apparatus in paragraphs [0035 - 0039].

The applicants respectfully submit that claims 36-38 recite statutory subject matter under 35 U.S.C. § 101 in view of the foregoing. Therefore, the applicants respectfully request that this ground of rejection be withdrawn.

Rejections under 35 U.S.C. § 102

Claims 1-11, 17-22, 25-32, 34 and 36-38 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2003/0131095 ("the Kumhyr publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Claims 1-11, 17-22, 25-28 and 36-38

Independent claims 1 and 36, as amended, are not anticipated by the Kumhyr publication because the Kumhyr publication does not teach an act of (or means for) signaling the availability of at least a portion of the resource to a second entity to render alternative content if it is determined that a condition is not met.

In rejecting original claims 1 and 36, the Examiner cited Figure 4 and paragraphs [0030] and [0034] as teaching that if a condition is not met, a first entity allowing a second entity to use at least a portion of the resource to render content. (See Paper No. 20070521, page 6.) The applicants respectfully disagree.

The Kumhyr system "monitor[s] web pages for content deemed inappropriate by the sponsor of advertising to be inserted in [a] web page." (See paragraph [0023] of the Kumhyr publication.) If an ad contains display restrictions, a censor subprocess to monitor the datastream is launched. If certain key items in the datastream are matched, a determination is made of if the item matched is absolutely prohibited. (See elements 404

and 406 of Figure 4.) ***If the key item is absolutely prohibited, the censor is terminated without rendering content in the available resource.*** (See elements 418 and 422 of Figure 4.) Thus, as can be appreciated from the foregoing, if a key item matched is absolutely prohibited, the Kumhyr publication does not teach signaling the availability of at least a portion of the resource to a second entity to render alternative content as claimed.

In the Kumhyr publication, if there is a key item match, but the item is not absolutely prohibited, a match count is incremented. (See element 408 of Figure 4.) If either the match count is exceeded or negative semantic context is determined within the target document, an exception sub-process is launched. (See elements 412 and 414 of Figure 4.) The Examiner contends that this exception sub-process corresponds to a first entity allowing a second entity to use at least a portion of the resource to render content. However, the exception sub-process in the Kumhyr system is merely requesting approval to display the original ad in question. The Kumhyr system does not request alternative content to be rendered. (See Figure 6.) ***If the sponsor does not approve the ad placement, the system returns to step 426 and terminates at step 422 without rendering content in the available resource.*** Furthermore, regardless of whether the sponsor approves or disapproves of the ad placement, in neither case does ***the sponsor in the exception subprocess*** (i.e., the Examiner's second entity) provide ***alternative content*** to be rendered via the resource (i.e., the ad is either provided or not provided).

As can be appreciated from the foregoing, the Kumhyr publication does not teach signaling the availability of at least a portion of the resource to a second entity to render alternative content in the event that it is determined that a condition is not met. Thus, independent claims 1 and 36, as amended, are not anticipated by the Kumhyr publication. Since claims 2-11, 17-22 and 25-28 depend, either directly or indirectly, from claim 1, and since claims 37 and 38 depend from claim 36, they are similarly not anticipated by the Kumhyr publication.

Claims 29-32 and 34

Independent claim 29, as amended, is not anticipated by the Kumhyr publication because the Kumhyr publication does not teach determining, based on a set of one or more conditions, whether to provide at least one ad responsive to a request, and if not, redirecting the request to an alternative entity. In rejecting original claim 29, the Examiner cited Figure 4 and paragraph [0030] as teaching that if an ad is not provided, the request to provide content to be rendered is redirected to an alternative entity. (See Paper No. 20070521, page 11.) The applicants respectfully disagree.

The cited section of the Kumhyr publication concerns launching the exception subprocess if certain semantic context is identified within the datastream of content to be rendered. As discussed with respect to independent claim 1 above, the exception sub-process in the Kumhyr publication is merely requesting approval to display the original ad in question, and does not **request content to**

be rendered by an alternative entity as recited in the claim 29. Thus, independent claim 29 is not anticipated by the Kumhyr publication. Since claims 30-32 and 34 depend from claim 29, they are similarly not anticipated by the Kumhyr publication.

Rejections under 35 U.S.C. § 103

Claims 12-16, 33 and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Kumhyr patent in view of U.S. Patent Publication No. 2003/0220918 ("the Roy publication").

Claims 12-16, 33 and 35

First, claims 12-16 indirectly depend from claim 1, and claims 33 and 35 depend, either directly or indirectly, from claim 29. The proposed combination would not compensate for the deficiencies of the Kumhyr publication with respect to claims 1 and 29, discussed above, regardless of the scope of purported disclosure in the Roy publication and the absence or presence of motivation to combine. Consequently, claims 12-16, 33 and 35 are not rendered obvious by the cited references for at least this reason.

In addition, claim 12, as amended, is not rendered obvious by the cited references because neither the Kumhyr publication, nor the Roy publication, either taken alone or in combination, teach or suggest that the acceptance of an ad to be rendered by a first entity is based on the determination that net revenue for rendering the ad will be positive. In rejecting original claim 12,

the Examiner contends that paragraph [0019] of the Roy publication teaches that the condition to render the ad by the first entity is met if the first entity determines that net revenue for rendering the ad will be positive. (See Paper No. 20070521, page 14.) The applicants respectfully disagree.

The Roy publication concerns a system of setting a cost-per-click using an auction and allowing advertisers to pick the search terms where their ads should appear. (See paragraph [0011].) The advertisers determine how much they want to spend on a search term and the search provider displays the advertiser's listing in proportion to the amount of money the advertisers spend. Specifically, the portion of paragraph [0019] cited by the Examiner states:

[w]hen an advertiser wants to buy clicks, the search engine provider comes up with a cost-per-click that depends on how often he expects users to click on the advertiser's listing, and how much total advertising he expects to sell.

As stated, the Roy publication does not determine whether an ad is to be displayed **based on whether net revenue is positive or not**. The Roy system renders ads until the number of clicks paid for by the advertiser is achieved or until the user completes a specific number of searches. (See paragraph [0021].) This clearly does not teach or suggest that the acceptance of an ad to be rendered by a content ad system is based on the determination made by the content ad system that net revenue for rendering the ad will be positive.

As can be appreciated from the foregoing, dependent claim 12 is not rendered obvious by the Kumhyr and Roy publications for at least this additional reason. Since claims 13-16 depend, either directly or indirectly, from claim 12, they are similarly not rendered obvious by the cited references.

Claims 23 and 24

Claims 23 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Kumhyr patent in view of U.S. Patent Application No. 6,959,424 ("the Gardener patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Claims 23 and 24 indirectly depend from claim 1. The proposed combination would not compensate for the deficiencies of the Kumhyr publication with respect to claim 1, discussed above, regardless of the scope of purported disclosure in the Gardner patent and the absence or presence of motivation to combine. Consequently, claims 23 and 24 are not rendered obvious by the cited references for at least this reason.

Conclusion

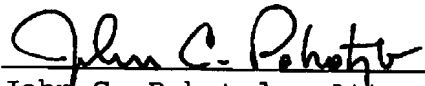
In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

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Any arguments made in this amendment pertain **only** to the specific aspects of the invention **claimed**. Any claim amendments or cancellations, and any arguments, are made **without prejudice to, or disclaimer of**, the applicants' right to seek patent protection of any unclaimed (e.g., narrower, broader, different) subject matter, such as by way of a continuation or divisional patent application for example.

Respectfully submitted,

October 4, 2007

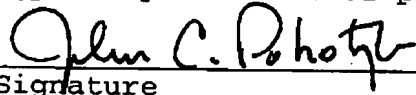

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